

REMARKS:

Claims 1-29 are currently pending in the application.

The Information Disclosure Statement filed on 28 November 2001 is objected to for certain informalities.

Claims 1-9, and 29 stand rejected under 35 U.S.C. § 112, first paragraph, as allegedly failing to comply with the written description requirement.

Claims 1-29 stand rejected under 35 U.S.C. § 103(a) over U.S. Publication No. 2002/0032637 to Moshal *et al.* ("*Moshal*") in view of the Examiner's Official Notice.

By this Amendment, the Applicant has amended Claims 1, 7-9, and 29 to expedite prosecution of this Application and to more particularly point out and distinctly claim the subject matter which the Applicant regards as the invention. The Applicant respectfully submits that these amendments are not necessitated by any prior art and are unrelated to the patentability of the present invention. By making these amendments, the Applicant makes no admission concerning the merits of the Examiner's rejection, and respectfully reserve the right to address any statement or averment of the Examiner not specifically addressed in this response. Particularly, the Applicant reserves the right to pursue broader claims in this Application or through a continuation patent application. No new matter has been added.

NON-STATUTORY DOUBLE PATENTING:

The Applicant thanks the Examiner for withdrawing the rejections of Claims 1-29 under the judicially created doctrine of obviousness-type double patenting.

INFORMATION DISCLOSURE STATEMENT:

The Examiner states that "it is unclear what reference has been submitted". The Applicant respectfully submits that the Applicant submitted a copy of reference U. The Applicant respectfully requests the Examiner to consider reference U.

REJECTION UNDER 35 U.S.C. § 112, FIRST PARAGRAPH:

Claims 1-9, and 29 stand rejected under 35 U.S.C. § 112, first paragraph, as allegedly failing to comply with the enablement requirement. The Applicant respectfully disagrees.

Nonetheless, the Applicant has amended Claims 1, 7-9, and 29 to expedite prosecution of this Application and to more particularly point out and distinctly claim the subject matter which the Applicant regards as the invention. By making these amendments, the Applicant does not indicate agreement with or acquiescence to the Examiner's position with respect to the rejections of these claims under 35 U.S.C. § 112, as set forth in the Office Action.

The Applicant respectfully submits that amended independent Claims 1 and 29 are considered to be in full compliance with the requirements of 35 U.S.C. § 112. The Applicants further respectfully submit that amended independent Claims 1 and 29 are in condition for allowance.

With respect to dependent Claims 2-9, these claims depend from amended independent Claim 1. As mentioned above, amended independent Claim 1 is considered to be in full compliance with the requirements of 35 U.S.C. § 112. Thus, dependent Claims 2-9 are considered to be in condition for allowance for at least the reason of depending from an allowable claim. Thus, the Applicant respectfully requests that the rejection of Claims 1-9, and 29 under 35 U.S.C. § 112 be reconsidered and that Claims 1-9, and 29 be allowed.

REJECTION UNDER 35 U.S.C. § 112, SECOND PARAGRAPH:

The Applicant thanks the Examiner for withdrawing the rejection of Claims 2-5, 11-14, 20-23, and 29 under 35 U.S.C. § 112, second paragraph.

REJECTION UNDER 35 U.S.C. § 103(a):

Claims 1-29 stand rejected under 35 U.S.C. § 103(a) over U.S. Publication No. 2002/0032637 to Moshal *et al.* ("*Moshal*") in view of the Examiner's Official Notice.

The Applicant respectfully submits that the ***amendments to independent Claims 1 and 29 have rendered moot the Examiner's rejection of these claims and the Examiner's arguments in support of the rejection of these claims.*** The Applicant further respectfully submits that amended independent Claims 1 and 29 in their current amended form contain unique and novel limitations that are not taught, suggested, or even hinted at in *Moshal* or the Examiner's Official Notice, either individually or in combination. Thus, the Applicant respectfully traverses the Examiner's obvious rejection of Claims 1-29 under 35 U.S.C. § 103(a) over the proposed combination of *Moshal* or the Examiner's Official Notice, either individually or in combination.

The Proposed *Moshal*-Official-Notice Fails to Disclose, Teach, or Suggest Various Limitations Recited in Applicant's Claims

For example, with respect to independent Claim 1, this claim recites:

A ***system for providing visualization of market offers***, comprising:

an electronic marketplace operable to receive offer data for a plurality of offers, the received offer data reflecting values specified in the offers for a plurality of offer variables; and

a market server operable to generate a display of the received offer data, the display comprising a plurality of patterns, each pattern representing a particular offer and comprising a plurality of bars, each bar representing a particular offer variable and comprising a set of one or more geometric display elements that by virtue of their appearance collectively encode, according to a predefined encoding scheme, a value for the offer variable corresponding to the bar. (Emphasis Added).

Independent Claim 10, 19, 28, and 29 recite similar limitations. *Moshal* or the Examiner's Official Notice fail to disclose each and every limitation of independent Claims 1, 10, 19, 28, and 29.

The Office Action Acknowledges that *Moshal* Fails to Disclose Various Limitations Recited in Applicant's Claims

The Applicant respectfully submits that the Office Action acknowledges, and the Applicant agrees, that *Moshal* fails to disclose the Applicant's claim limitations. Specifically the Examiner acknowledges that *Moshal* fails to teach a "system/method/software comprising: a plurality of bars, each bar representing a particular offer variable". (28 December 2006 Final Office Action, Page 4). However, the Examiner asserts Official Notice over the acknowledged shortcomings in *Moshal*. The Applicant respectfully traverses the Examiner's Official Notice.

The Examiner's *Official-Notice* is improper under MPEP § 2144.03

The Applicant respectfully submits that the Applicant is confused as to what the Examiner teaches by the Official Notice or even to the extent in which the Examiner is taking Official Notice. The Applicant respectfully request clarification as to the subject matter for which Official Notice is being taken. ***The Applicant respectfully traverses the Official Notice because the asserted facts, as best understood by the Applicant, is not supported by substantial documentary evidence or any type of documentary evidence*** and appear to be the Examiner's opinions formulated using the subject Application as a template, which constitutes impermissible use of hindsight. Furthermore, under these circumstances, it is inappropriate for the Examiner to take Official Notice without documentary evidence to support the Examiner's conclusion. (See MPEP § 2144.03). ***The Applicant respectfully requests the Examiner to produce authority for the Examiner's Official Notice.***

Only “in limited circumstances,” is it “appropriate for an examiner to take official notice of facts not in the record or to rely on common knowledge in making a rejection”. (MPEP § 2144.03). “Official notice unsupported by documentary evidence ***should only be taken by the examiner*** where the facts asserted to be well-known, or to be common knowledge in the art are ***capable of instant and unquestionable demonstration as being well-known***.”

With respect to the subject Application, the Examiner’s statement that “Official Notice is taken that it was old and well-known at the time the invention was made to use charts and graphs to present and analyze numerical and text data”, ***is not capable of instant and unquestionable demonstration as being well-known***. (28 December 2006 Final Office Action, Page 4). As noted by the court in *In re Ahlert*, 424 F.2d 1088, 1091, 165 USPQ 418, 420 (CCPA 1970), the notice of facts beyond the record which may be taken by the examiner must be ‘***capable of such instant and unquestionable demonstration as to defy the dispute***’ (citing *In re Knapp Monarch Co.*, 296 F.2d 230, 132 U.S.P.Q. 6 (C.C.P.A. 1961)).” (MPEP § 2144.03(A)). (Emphasis Added).

“It is ***never appropriate to rely solely on “common knowledge” in the art without evidentiary support in the record***, as the principal evidence upon which a rejection was based. *Zurko*, 258 F.3d at 1385, 59 USPQ2d at 1697. As the court held in *Zurko*, an assessment of basic knowledge and common sense that is not based on any evidence in the record lacks substantial evidence support. *Id.* at 1385, 59 USPQ2d at 1697. See also *In re Lee*, 277 F.3d 1338, 1344-45, 61 USPQ2d 1430, 1434-35 (Fed. Cir. 2002).” (MPEP § 2144.03(A)).

“Ordinarily, there must be some form of evidence in the record to support an assertion of common knowledge. See *Lee*, 277 F.3d at 1344-45, 61 USPQ2d at 1434-35 (Fed. Cir. 2002); *Zurko*, 258 F.3d at 1386, 59 USPQ2d at 1697 (holding that ***general conclusions concerning what is “basic knowledge” or “common sense” to one of ordinary skill in the art without specific factual findings and some concrete evidence in the record to support these findings will not support an obviousness rejection***). The examiner must provide specific factual findings predicated on sound

technical and scientific reasoning to support his or her conclusion of common knowledge. See *Soli*, 317 F.2d at 946, 37 USPQ at 801; *Chevenard*, 139 F.2d at 713, 60 USPQ at 241. The applicant should be presented with the explicit basis on which the examiner regards the matter as subject to official notice and be allowed to challenge the assertion in the next reply after the Office action in which the common knowledge statement was made.” (MPEP § 2144.03(B)). (Emphasis Added).

The Applicant respectfully submits that the Office Action provides no documentary evidence to support the Official Notice taken by the Examiner, yet the asserted facts are not capable of “instant and unquestionable” demonstration as being well-known. The Applicant further respectfully submits that the Applicant has adequately traversed the Examiner’s assertion of Official Notice and direct the Examiner’s attention to the pertinent text of the MPEP, which states:

If applicant adequately traverses the examiner’s assertion of official notice, the examiner must provide documentary evidence in the next Office action if the rejection is to be maintained. See 37 CFR 1.104(c)(2). See also *Zurko*, 258 F.3d at 1386, 59 USPQ2d at 1697 (“[T]he Board [or examiner] must point to some concrete evidence in the record in support of these findings” to satisfy the substantial evidence test). If the examiner is relying on personal knowledge to support the finding of what is known in the art, the examiner must provide an affidavit or declaration setting forth specific factual statements and explanation to support the finding. See 37 CFR 1.104(d)(2). (MPEP § 2144.03(C)).

Thus, if the Examiner continues to maintain the rejection of Claims 1-29 based on the Official Notice, the Applicant respectfully requests that the Examiner provide documentary evidence as necessitated by MPEP § 2144.03(C). Furthermore, if the Examiner is relying on personal knowledge to support the finding of what is known in the art, the Applicant further respectfully requests that the Examiner provide an affidavit or declaration setting forth specific factual statements and explanation to support the finding as further necessitated by MPEP § 2144.03(C).

In addition, the Applicant respectfully points the Examiner to the pertinent sections of the MPEP, directly on point to determine whether the next Office Action should be made

Final. In particular, the Applicant respectfully directs the Examiner's attention to the pertinent text of the MPEP, which states:

If the examiner adds a reference in the next Office action after applicant's rebuttal, and the newly added reference is added only as directly corresponding evidence to support the prior common knowledge finding, and it does not result in a new issue or constitute a new ground of rejection, the Office action may be made final. If no amendments are made to the claims, the examiner must not rely on any other teachings in the reference if the rejection is made final. If the newly cited reference is added for reasons other than to support the prior common knowledge statement and a new ground of rejection is introduced by the examiner that is not necessitated by applicant's amendment of the claims, the rejection may not be made final. (MPEP § 2144.03(D)).

The Office Action Fails to Properly Establish a *Prima Facie* case of Obvious over the Proposed *Moshal*-Official-Notice Combination

The Applicant respectfully submits that the Office Action fails to properly establish a *prima facie* case of obviousness based on the proposed combination of *Moshal* or the Examiner's Official Notice, either individually or in combination. The Office Action has not shown the required teaching, suggestion, or motivation in these references or in knowledge generally available to those of ordinary skill in the art at the time of the invention to combine these references as proposed. The Office Action merely states that "it would have been obvious to one of ordinary skill in the art at the time of the invention **to modify the teachings of *Moshal* to provide a system/method/software for providing visualization of market offers**, comprising a computer system operable to: receive offer data for a plurality of offers, the received offer data reflecting values specified in the offers for a plurality of offer variables; and generate a display of the received offer data, the display comprising a plurality of patterns, each pattern representing a particular offer and comprising a plurality of bars, each bar representing a particular offer variable and comprising a set of one or more geometric display elements that by virtue of their appearance collectively encode, according to a predefined encoding scheme, a value for the offer variable corresponding

to the bar.” (28 December 2006 Final Office Action, Pages 4-5). (Emphasis Added). The Applicant respectfully disagrees.

The Applicant further respectfully submits that this purported advantage relied on by the Examiner is nowhere disclosed, taught, or suggested in *Moshal* or the Examiner's Official Notice, either individually or in combination. In fact, the Examiner is silent on any motivation to combine the references as proposed. (28 December 2006 Final Office Action, Pages 4-5). The Applicant respectfully requests clarification as to how the Examiner arrives at any motivation to combine. For example, how would it have been obvious to one of ordinary skill in the art at the time of the invention to modify the teachings of *Moshal* to provide Applicant's claimed invention? ***The Applicant respectfully requests the Examiner to point to the portions of Moshal or the Examiner's Official Notice which contain the teaching, suggestion, or motivation to combine these references for the Examiner's stated purported advantage.*** The Applicant further respectfully submits that the Examiner is using the subject Application as a template to formulate reconstructive hindsight, which constitutes impermissible use of hindsight under 35 U.S.C. § 103(a).

A recent Federal Circuit case makes it crystal clear that, in an obviousness situation, the ***prior art must disclose each and every element of the claimed invention, and that any motivation to combine or modify the prior art must be based upon a suggestion in the prior art.*** *In re Lee*, 61 U.S.P.Q.2d 1430 (Fed. Cir. 2002). (Emphasis Added). Conclusory statements regarding common knowledge and common sense are insufficient to support a finding of obviousness. *Id.* at 1434-35. With respect to the subject Application, the ***Examiner has not adequately supported the selection and combination of Moshal or the Examiner's Official Notice to render obvious the Applicant's claimed invention.*** The Examiner's unsupported conclusory statements that it would have been obvious to one of ordinary skill in the art at the time of the invention ***to modify the teachings of Moshal to provide*** Applicant's claimed invention, ***does not adequately address the issue of motivation to combine.*** (28 December 2006 Final Office Action, Pages 4-5). This factual question of motivation is material to patentability, and cannot be resolved on subjective belief and

unknown authority. *Id.* It is improper, in determining whether a person of ordinary skill would have been led to this combination of references, simply to "[use] that which the inventor taught against its teacher." *W.L. Gore v. Garlock, Inc.*, 721 F.2d 1540 (Fed. Cir. 1983). Thus, ***the Office Action fails to provide proper motivation for combining the teachings of Moshal or the Examiner's Official Notice***, either individually or in combination.

The Applicant's Claims are Patentable over the Proposed Moshal-Official-Notice Combination.

The Applicant respectfully submits that independent Claims 1, 10, 19, 28, and 29 are considered patentably distinguishable over the proposed combination of *Moshal* and the Examiner's Official Notice. With respect to dependent Claims 2-9, 11-18, and 20-26: Claims 2-9 depend from independent Claim 1; Claims 11-18 depend from independent Claim 10; and Claims 20-26 depend from independent Claim 19. As mentioned above, each of independent Claims 1, 10, 19, 28, and 29 are considered patentably distinguishable over the proposed combination of *Moshal* and the Examiner's Official Notice. Thus, dependent Claims 2-9, 11-18, and 20-26 are considered to be in condition for allowance for at least the reason of depending from an allowable claim.

For at least the reasons set forth herein, the Applicant respectfully submits that Claims 1-29 are not rendered obvious by the proposed combination of *Moshal* or the Examiner's Official Notice. The Applicant further respectfully submits that Claims 1-29 are in condition for allowance. Thus, the Applicant respectfully requests that the rejection of Claims 1-29 under 35 U.S.C. § 103(a) be reconsidered and that Claims 1-29 be allowed.

THE LEGAL STANDARD FOR OBVIOUSNESS REJECTIONS UNDER 35 U.S.C. § 103:

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, ***there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings.*** Second, there must be a

reasonable expectation of success. Finally, **the prior art reference** (or references when combined) **must teach or suggest all the claim limitations**. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and **not based on applicant's disclosure**. *In re Vaeck*, 947 F.2d 488, 20 U.S.P.Q.2d 1438 (Fed. Cir. 1991); M.P.E.P. § 2142. Moreover, all the claim limitations must be taught or suggested by the prior art. *In re Royka*, 490 F.2d 981, 180 U.S.P.Q. 580 (CCPA 1974). If an independent claim is nonobvious under 35 U.S.C. § 103, then any claim depending therefrom is nonobvious. *In re Fine*, 837 F.2d 1071, 5 U.S.P.Q.2d 1596 (Fed. Cir. 1988); M.P.E.P. § 2143.03.

With respect to alleged obviousness, **there must be something in the prior art as a whole to suggest the desirability**, and thus the obviousness, of making the combination. *Panduit Corp. v. Dennison Mfg. Co.*, 810 F.2d 1561 (Fed. Cir. 1986). In fact, the absence of a suggestion to combine is dispositive in an obviousness determination. *Gambro Lundia AB v. Baxter Healthcare Corp.*, 110 F.3d 1573 (Fed. Cir. 1997). The mere fact that the prior art can be combined or modified does not make the resultant combination obvious unless the prior art also suggests the desirability of the combination. *In re Mills*, 916 F.2d 680, 16 U.S.P.Q.2d 1430 (Fed. Cir. 1990); M.P.E.P. § 2143.01. The consistent criterion for determining obviousness is whether the prior art would have suggested to one of ordinary skill in the art that the process should be carried out and would have a reasonable likelihood of success, viewed in the light of the prior art. Both the suggestion and the expectation of success must be founded in the prior art, not in the Applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 U.S.P.Q.2d 1438 (Fed. Cir. 1991; *In re O'Farrell*, 853 F.2d 894 (Fed. Cir. 1988); M.P.E.P. § 2142.

A recent Federal Circuit case makes it clear that, in an obviousness situation, the prior art must disclose each and every element of the claimed invention, and that any motivation to combine or modify the prior art must be based upon a suggestion in the prior art. *In re Lee*, 61 U.S.P.Q.2d 1430 (Fed. Cir. 2002). Conclusory statements regarding common knowledge and common sense are insufficient to support a finding of obviousness. *Id.* at 1434-35.

CONCLUSION:

In view of the foregoing amendments and remarks, this application is considered to be in condition for allowance, and early reconsideration and a Notice of Allowance are earnestly solicited.

A Request for Continued Examination (RCE) is being filed electronically herewith to facilitate the processing of this deposit account authorization. **The Commissioner is hereby authorized to charge the \$790.00 RCE fee, to Deposit Account No. 500777.** Although the Applicant believes no additional fees are deemed to be necessary; the undersigned hereby authorizes the Commissioner to charge any additional fees which may be required, or credit any overpayments, to **Deposit Account No. 500777.** If an extension of time is necessary for allowing this Response to be timely filed, this document is to be construed as also constituting a Petition for Extension of Time Under 37 C.F.R. § 1.136(a) to the extent necessary. Any fee required for such Petition for Extension of Time should be charged to **Deposit Account No. 500777.**

Please link this application to Customer No. 53184 so that its status may be checked via the PAIR System.

Respectfully submitted,

28 March 2007
Date

/Steven J. Laureanti/signed
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